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IN THE

Supreme Court of the United States

October Term, 1979

No. 79-1661

KEARNEY-NATIONAL, INC.,

Petitioner,

vs.

BURNDY CORPORATION,

Respondent.

BRIEF FOR RESPONDENT BURNDY CORPORATION IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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TABLE OF CONTENTS

PAGE

Statement of the Case 2

The Opinion Below 3

The District Court Applied the Statutory Presumption 4

The Argument that the Court Invalidated the Patent Over the Same Prior Art Considered by the Examiner Is Speculative at Best 4

Argument

Reasons Why the Writ Should Be Denied 6

Conclusion 7

TABLE OF AUTHORITIES

Dual Manufacturing & Engineering, Inc. et al v. Burris Industries, Inc. et al, No. 79-1136 decided April 22, 1980 6

Graver Tank & Mfg. Co. v. Linde Air Prod. Co., 336 U.S. 271 (1949) 2

Magnum Import Co. v. Coty, 262 U.S. 159 (1923) 2

Sakraida v. Ag Pro Inc., 425 U.S. 273 (1976) 2

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This is an ordinary patent case in which both the district court and the Court of Appeals for the Second Circuit found the patent invalid for obviousness; indeed, the appellate decision was *per curiam*.

The subject matter of the patent is an electrical connector in the form of the letter "H." Electrical cables are placed in each of the upper and lower bights of the "H" and thereafter the upper and lower arms defining the bights are compressed to enclose the respective cables. The patented "invention" was to remove metal from the opposite

sides of the "H," to make the "H" more easily compressible. The inventive merit of the patented subject matter, makes the barn cleaning technique claimed in *Sakraida* v. *Ag Pro Inc.*, 425 U.S. 273 (1976), appear as recondite technology.

Petitioner is simply looking to this Court for another hearing. As this Court has said, however, "jurisdiction was not conferred upon this court merely to give the defeated party in the circuit court of appeals another hearing." *Magnum Import Co.* v. *Coty*, 262 U.S. 159, 163 (1923).

This Court does not undertake review of concurring findings by two courts below, in the absence of a very obvious and exceptional showing of error. *Graver Tank & Mfg. Co.* v. *Linde Air Prod. Co.*, 336 U.S. 271, 275 (1949).

The petition seeks review of the concurring decisions below on the ground that the district court "gave no recognition to the presumption of validity."* The issue, therefore, is essentially one of fact, and as we shall demonstrate, is erroneously stated by petitioner.

Statement of the Case

Petitioner's "Statement of the Facts" (Pet. 5) sets forth an incomplete and inaccurate review of the facts. The comprehensive opinion of the district court (A 4-A 41) sets forth most of the salient facts. We offer, however, a brief supplementary statement to complete the presentation.

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* Petition at page 11.

The "H" connector covered by the patent in issue is shown at A-40, 41. It consists of an "H" frame, with extension tabs at top and bottom, and with side grooves to facilitate compressibility.

The prior art consists of an "H" frame (A-35); an "H" frame with extension tabs and side grooves (A-36); an "H" frame with side grooves exactly as shown in the patent in suit (A-39); an "H" frame with extension tabs and internal grooves (A-38); and a connector in the shape of the number "6" with side grooves on opposite sides of the loop.

Thus, at the outset, it must be appreciated, there is no inventive contribution in the subject matter of the patent in suit. It was allowed only because of deceptive practice in which the petitioner engaged before the patent examiner, which is not relevant to this reply; but see A-22, where the district court characterizes the conduct of petitioner as "the usual jockeying that occurs in the prosecution of a patent."

The Opinion Below

Petitioner mis-states the district court's decision. Petitioner, in its statement under "Reasons For Granting the Writ," contends that the district court, first, ignored the statutory presumption, and, second, invalidated the patent over the same prior art considered by the patent examiner. Both statements are incorrect.

The District Court Applied the Statutory Presumption.

The district court correctly stated and applied the presumption of validity (A-31, fn. 31). The presumption applied was that "reasonable doubt on the question of validity be resolved in favor of the patent holder." After applying that presumption, the court found "There is no such reasonable doubt here."

The Argument that the Court Invalidated the Patent over the Same Prior Art Considered by the Examiner Is Speculative at Best.

The patent is a result of two applications having been filed *seriatim* in the Patent Office.

The first application was directed to an "H" frame connector which provided for grooves either on the inside of the sockets or on the outside of the "H"; and, if formed on the outside, the grooves could be located intermediate the upper and lower sockets.

The examiner rejected that application as unpatentable over a patent to Hoffman (A-36), or two Toedtman patents (A-37, 38). The Hoffman patent (also owned by petitioner) was cited by the examiner as disclosing everything the petitioner was attempting to re-patent in the first application. The first Toedtman patent (A-38) was cited for showing the "H" frame, and the second Toedtman patent (A-37) was cited for disclosing grooves on the outside of the connector.

Petitioner thereupon abandoned the first application, and filed its second application. In the second application,

it injected complex-looking mathematical formulae which purportedly defined "critical" spacing between the grooves and the sockets.

According to the search record of the second application, the examiner did *not* cite the prior patents to Graham (A-35), Hoffman (A-36) or Toedtman (A-37), although he did cite the other Toedtman patent (A-38) and a Lynch patent (A-39). The examiner rejected the claims and indicated he did not understand the formulae.

Petitioner argued that the space relationships between the grooves and sockets were critical, and that the formulae were an essential tool in designing the connectors. As a result of those arguments, the examiner allowed the patent.

Contrary to those arguments, however, petitioner knew that the formulae were virtually meaningless. In fact, the formulae produced results indicating that the grooves could be anywhere; i.e., closer to or further away from either socket, or indeed even equidistant between the sockets, exactly as in the prior art. Those results were withheld from the examiner.

Indeed, at the time that petitioner was urging "criticality" of space relationships to the examiner, petitioner was purposefully designing many satisfactory "H" connectors in which the spacing fell outside the so-called critical ranges.

Thus, the allowance of the second application, although the result of conduct less than forthright with the examiner, came without the second examiner citing all of the prior art made of record by respondent in this case, and considered pertinent by the district court in adjudicating the validity issue.

ARGUMENT

Reasons Why the Writ Should Be Denied

The petition presents no proper question involving "special and important reasons" such as required under Rule 17 of this Court.

This is essentially a private dispute, and the question presented by the petitioner as to whether the district court applied the statutory presumption is primarily one of fact; hardly the kind of question to justify the grant of a writ.

Moreover, the patent is directed to subject matter which is indistinguishable over the prior art and, apart from any presumption, the patent was overwhelmingly proven to be obvious and invalid. The patent was issued only because of deception practiced on the examiner.

The argument is also made by petitioner that the circuits impose different burdens to overcome the statutory presumption. Generally, the weight of persuasion applied by the circuits has fallen into two semantically different categories. The first category requires "clear and convincing evidence"; the 3rd, 9th and 10th Circuits support this burden. The second category requires a preponderance of the evidence; the 2nd, 4th, 6th, 7th* and 8th Circuits support this standard.

The difference between "clear and convincing" and a "preponderance of the evidence" is, we submit, extremely

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* The Seventh Circuit in a recent *en banc* decision, *Dual Manufacturing & Engineering, Inc. et al* v. *Burris Industries, Inc. et al*, No. 79-1136 decided April 22, 1980, quoted with approval the Second Circuit standard, in a decision not yet reported.

subtle, if even existent and as a practical matter, the result would be the same irrespective of which standard were applied; see, e.g., Black's Law Dictionary, 4th Edition.

Indeed, in this case, the district court held there was no "reasonable doubt" of the invalidity of the patent. That determination would satisfy either burden applied by the courts.

Conclusion

We respectfully submit, the petition should be denied.

Respectfully submitted,

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